



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/134,417	08/14/98	ROSS	22789 XS

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EXAMINER

RIM,V

ART UNIT
1614

PAPER NUMBER

DATE MAILED:

09/02/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/134,417

Applicant(s)
Ross et al

Examiner
Vickie Kim

Group Art Unit
1614



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-26 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-26 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

KEITH D. MacMILLAN
PRIMARY EXAMINER

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10, 21, and 23-24 are, drawn to a method of treating vision disorders, comprising administering an effective amount of a pipecolic acid derivative, classified in class 514.
 - II. Claims 1-4 , 6-10 and 23-24 are, drawn to a method of treating memory disorders, comprising administering an effective amount of a pipecolic acid derivative, classified in class 514.
 - III. Claims 11-20, 22 and 25-26 are, drawn to a composition containing a a pipecolic acid derivative , classified in class 514.
2. Inventions I , II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). Because these inventions are distinct for the reasons given above and the search required for Group I and II are not required for Group III. A reference which anticipates the invention of Group I and II would not render the invention of Group III obvious, absent ancillary art, restriction for examination purposes as indicated is proper.
3. In the case, restriction is required to group I and II. The inventions can be shown to be distinct, since group I and II contain patentable distinct two subject matters as follows.
 - I. Vision related disorders.
 - II. Memory related disorders.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Election

4. Upon electing a group, applicant is further required to elect a single disclosed species of a pipercolic acid derivative. Applicant should express the elected species in terms of the variables of the elected formula.

Election of species is required per MPEP 803,809.02(d) (Markush group claim practice, separate and burdensome fields of search required).

Patentably distinct markush species are independent inventions, *In re Webber*, 198 USPQ 328, *In re Haas*, 198 USPQ 334. Divisional applications may be filled under 35 USC 121, as a result of an office requirement for an election of a patentably distinct species as made herein. *In re Joyce*, 115 USPQ 412. This satisfies the "patentably distinct" criterion since the examiner is not of the opinion that various species are obviously unpatentable over one another and each species (as noted above) is capable of independent manufacture, use, and sale, with the other components of the claimed formulations.

Applicant is further required under 35 U.S.C. 121 to elect a single disclosed species, even

though this requirement is traversed.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Vickie Kim* whose telephone number is (703)305-1675.



Vickie Kim, patent examiner

August 30, 1999